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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,143	10/13/2005	Giacomo Gorni	05788.0347	2105
22852	7590	07/06/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			RAHLL, JERRY T	
			ART UNIT	PAPER NUMBER
			2874	

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/529,143	Applicant(s) GORNI ET AL.	
	Examiner Jerry T. Rahll	Art Unit 2874	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-47 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 24-47 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/24/05, 10/13/05</u> | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements (IDS) submitted on March 24, 2005 and October 134, 2005 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

Drawings

2. The drawings submitted have been reviewed and determined to facilitate understanding of the invention. The drawings are accepted as submitted.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claims 24-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,091,870 to Eldada in view of US Patent Application Publication No. 2004/0022489 to Nesnidal et al.

6. Regarding Claim 24, Eldada describes an integrated optical device including first and second integrated waveguides (22, 24) in optical coupling relationship at first and second spaced apart coupling regions (26, 28) and having uncoupled waveguide sections between the coupling regions (see Figure 2), and first and second modulated refractive index structures (32), each formed along a respective uncoupled waveguide section with regions having a first refractive index and second refractive index regions adjacent to each other. Eldada does not specifically describe the regions of different refractive index comprising a portion of the uncoupled waveguide and a gap formed in the uncoupled waveguide with a 1.5% difference between the refractive indices of the regions. Nesnidal et al. describes waveguides having index structures (10), each formed along a waveguide with regions having a first refractive index (16) and second refractive index (20) adjacent to each other, where the regions of different refractive index comprising a portion of the uncoupled waveguide and a gap formed in the uncoupled waveguide with a 1.5% difference between the refractive indices of the regions (see paragraphs 0006 and 0019-0022). At the time of the invention it would have been obvious to one of ordinary skill in the art to use the grating structure of Nesnidal et al. in the device of Eldada. The motivation for doing so would have been to improve filtering ability of the Eldada structure (see Nesnidal et al. at paragraph 0007).

7. Regarding Claims 25 and 26, Nesnidal et al. describes the percentage difference greater than 50% (see paragraphs 0006 and 0019-0022).

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8. Regarding Claim 27, Eldada describes the waveguides comprising a core (10) and a cladding (6,8). Further, Nesnidal et al. describes the waveguide comprising a core (16) and a cladding (12), where the gap (20) extends across the entire cross section of the waveguide section.

9. Regarding Claim 28, Eldada describes interference between the regions of different refractive index arranged orthogonally to the light propagation direction of the waveguide sections (see Figure 2).

10. Regarding Claim 29, Eldada describes the refractive index structures comprising a plurality of pairs of regions arranged in succession (see Figure 2).

11. Regarding Claim 30, while Eldada does not describes a pair of the regions as a transmissive pair for a pass band with the other pairs for reflecting optical signals within a stop band, for the grating structure described by Eldada to function to isolate a band of wavelengths (see Eldada at Column 1), there must be such a transmissive pair regions in the described grating.

12. Regarding Claims 31 and 32, for Eldada to function as an Add/Drop Multiplexer device, it must inherently have the pass band functionality described by present claims 31 and 32.

13. Regarding Claims 33-36, neither Eldada nor Nesnidal et al. specifically describe the transmissive pairs as having either the same or varying optical lengths in the light propagation direction with varying numbers of reflective pairs between adjacent transmissive pairs.

However, such grating structures are well-known in the art. At the time of the invention, it would have been obvious to one of ordinary skill in the art to use such well-known grating structures in the combined Eldada and Nesnidal et al. device. The motivation for doing so would have been to construct the device to be operable to add or drop desired signals.

14. Regarding Claim 37, Eldada describes the optical coupling regions having coupling factors approximately equal to 50% (see Column 5 Lines 25-40).

15. Regarding Claim 38, Eldada describes the first and second modulated refractive index structures located along the uncoupled waveguide sections in identical positions respective of the first coupling region (see Figure 2).

16. Regarding Claim 39, Eldada describes the first waveguide having a first input section (34) adjacent the first coupling region (26) and the second waveguide having first (36) and second (38) output sections, respectively adjacent the first and second coupling regions, and further comprising a first optical path from the first input section to the first output section, the first optical path propagating from the first input section to the first output section a first optical signal (Output(Pass)) with wavelength in said pass band; and a second optical path from the first input section to the second output section, the second optical path propagating from the first input section to the second output section a second optical signal (Output(Drop)) with wavelength in said stop band but outside the pass band.\

17. Regarding Claim 40, Eldada describes the first waveguide further comprises a second input section adjacent the second coupling region (40), and the device further comprises a third optical path from the second input section to the second output section, the third optical path propagating from the second input section to the second output section a third second optical signal (Add) with wavelength in said pass band.

18. Regarding Claim 41, Eldada describes an add/drop device comprising first and second optical device as described above connected in cascade and having differential pass bands (see Figures 12-14). Further, a recitation that an element is “adapted to” perform a function is not a

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positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchinson, 69 USPQ 138.

19. Regarding Claim 42, Eldada describes the second output of the first device coupled to the first input of the second device (see Figures 12-14).

20. Regarding Claim 43, Eldada and Nesnidal et al. describe a method relating to the optical device above.

21. Regarding Claim 44, the cutting of the waveguide section described by Nesnidal et al. is a one-step process. Therefore, forming the grating structure of the combined device would include the cutting simultaneously in the uncoupled waveguide sections.

22. Regarding Claim 45, Nesnidal et al. describes using a mask to define the cuts and electively removing sections according to the mask (see paragraph 0021).

23. Regarding Claims 46 and 47, Nesnidal et al. describes filling the gaps with air (see paragraph 0021).

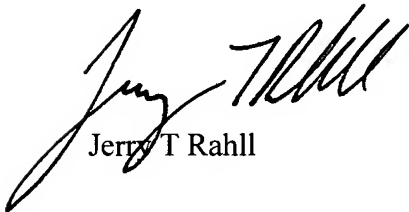
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry T. Rahll whose telephone number is (571) 272-2356. The examiner can normally be reached on M-Th (8:30-5:30).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on (571) 272-2344. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jerry T Rahll



**SUNG PAK
PRIMARY EXAMINER**